The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

SEP 30 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KRAMADHATI V. RAVI,
KENT ROSSMAN, TURGUT SAHIN,
and PRAVIN NARWANKAR

Appeal No. 2002-0059
Application No. 09/362,504

ON BRIEF

Before KIMLIN, GARRIS and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the appeal record leads us to conclude that this case is not in condition for a decision on appeal at this time. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

In item No. 2 at page 2 of the answer, the examiner maintains that Matsuura (U.S. Patent No. 5,319,247) is considered by the examiner as one of the references that is relied upon in a rejection of all of claims 17, 18, 25-28 and 32-34 under 35 U.S.C. § 103. That position of the examiner was seemingly formulated in response to appellants' assertion (brief, page 2) of a lack of harmony or logic in the examiner's application of the prior art to claims 28 and 30 when considering that claim 28 depends from claim 30.

In item No. 10 at page 5 of that same answer, the examiner refers to the final rejection for the statement of rejections that are to be maintained.

In that referred to final rejection (Paper No. 13) the following rejections are included:

(1) a rejection of claim 16 under 35 U.S.C. § 102(b) as anticipated by Onuki et al.;

(2) a rejection of claims 17, 18, 25-28 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Ye in view of Onuki et al., Boys et al. and Ramoarotafika et al.; and

(3) a rejection of claims 19-24, 29-31, 35 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Ye in view of Onuki et al., Boys et al., Ramoarotafika et al and Matsuura.

Thus, there is an inconsistency in the examiner's answer regarding the examiner's treatment and apparent intent to reject claims 17, 18, 25-28 and 32-34 under 35 U.S.C. § 103(a) as being unpatentable over Ye in view of Onuki et al., Boys et al., Ramoarotafika et al. and Matsuura as indicated by the statement under the Status of Claims heading (answer, page 2) and the lack of a presentation of a statement of a ground of rejection that is consonant therewith in the answer.

In this particular case, the above-noted inconsistency is exacerbated by the examiner's failure to fully explain how the assembled prior art is being applied to each of the several rejected claims, on a limitation by limitation basis. This is especially important where, as here, some of the claims are directed to an integrated circuit (claims 16, 23, 24 and 36), some are directed to a substrate processing system or chemical vapor deposition system involving a plasma generator or system therefor (claims 17-22 and 25-31) and other claims are directed to a computer readable storage medium (claims 32-35).

As a consequence and under the circumstances recounted above, the issues have not been fully developed by the examiner and this application is not ready for review on appeal given the mixed signals sent to us by the examiner concerning the

particular prior art that is being relied upon in rejecting each of the claims.

Accordingly, the subject application is being returned to the jurisdiction of the examiner for clarification of the record as to the prior art that is relied upon in any rejections that are maintained by the examiner. Moreover, for any rejections that may be maintained upon reconsideration by the examiner in light of this remand, a full explanation by the examiner as to how that prior art is being applied in any such rejections on a claim by claim basis and with full consideration of all limitations of each claim should be furnished by the examiner.

We remand this application to allow for the clarification of the file record by the examiner with respect to the rejections previously advanced by the examiner and for the examiner to reconsider the claimed subject matter in light of the above discussion. It is our determination that a supplemental examiner's answer will not effect the record clarification necessary in this case. As a consequence, we do not authorize a supplemental answer under 37 CFR § 1.193(b)(1)(1999) as an appropriate response to this remand.

This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure § 708.01 (8th ed., August 2001). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

EDWARD C. KIMLIN
Administrative Patent Judge

BRADLEY R. GARRIS
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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